

IN THE
United States Circuit Court of Appeals
For the Ninth Circuit

CLAYTON T. SAID and JOSEPH A. McCONNELL
APPELLANTS

VS.

TWOHY BROS. COMPANY, a Corporation
THE NORTHWESTERN EQUIPMENT COMPANY,
a Corporation, and
ELBERT G. CHANDLER
APPELLEES

UPON APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF OREGON

Appellees' Brief

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U. S. DISTRICT COURT



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CLAYTON T. EAID and JOSEPH A. McCONNELL
Appellants

vs.

TWOHY BROS. COMPANY, a Corporation,
THE NORTHWESTERN EQUIPMENT COM-
PANY, a Corporation, and
ELBERT G. CHANDLER,
Appellees.

Upon Appeal from the District Court of the United
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Appellees' Brief

APPELLEES' STATEMENT OF THE CASE.

The sole question involved in this suit is: Does a log bunk, built under U. S. Patent No. 1,066,795, issued July 8, 1913, to Elbert G. Chandler, one of the defendants herein (Page 77 of the Record), infringe U. S. Patent No. 901,815, issued to Joseph A. McConnell, October 20, 1908 (Page 73 of the Record), and a one-fourth interest in which was purchased on June 20, 1913, by Clayton T. Eaid, the initiating complainant herein? (Pages 19, 36 and 75 of Record.)

A great deal of evidence was introduced by complainants at the trial of this case, however, relative to a certain contractual relationship between Clayton T. Eaid, the initiating complainant herein, and Twohy Bros. Company, one of the defendants herein. That contract had to do solely with a certain invention of said Eaid in Improvements in Logging Bunks, for which he had filed an application for a patent, and which invention he was promoting at the time (Page 48 of Record). The contract had no connection whatever with the McConnell patent on which this suit was brought, for *Eaid had absolutely no interest in the McConnell patent at the time, and it was a year and six months after the date of that contract, and three months after the cancellation of said contract, that Eaid purchased a one-fourth interest in the McConnell patent.*

The manner in which this evidence was put into the case at the trial, caused the Court to remark (Page 30 of the transcript of the evidence, omitted from the Record) :

"The idea that I got from the allusion to the contract was that the McConnell Bunk was the subject matter of that contract, so I guess the contract better go into the evidence."

The following brief statement of the facts, therefore, shows the roundabout course taken by Eaid in his endeavor to force the defendants herein to pay him further for *his* invention, even after it had been fully tested at big expense to defendants, and proven to be not a commercial success (Bottom Page 63 and 64 of Record) :

On December 29, 1910, Eaid filed an application for a patent for "Improvements in Log Bunk and Stake for Railway Cars," which application he allowed to become abandoned in the Patent Office.

On December 22, 1911, Eaid entered into the above-mentioned contract with Twohy Bros. Company, wherein said Twohy Bros. Company was to undertake to manufacture and sell Eaid's bunk. (Defendants' Exhibit 1, Page 81 of Record).

On February 12, 1912, Eaid filed a second application for "Improvements in Logging Car Bunk and Stake" on which patent No. 1,055,150, issued March 4, 1913. (Defendants' Exhibit 3, Page 89 of Record).

On March 28, 1912, a supplemental agreement was entered into between the parties, wherein *"owing to the fact that there are other bunks on the market presenting a competition in the sale of such equipment and are sold for a less sum than is provided for in contract heretofore entered into between the parties,"* it was provided that the selling price for said Eaid Bunk as named in said original agreement, should be reduced. (Complainants' Exhibit G, Page 79 of Record).

On April 25, 1912, Eaid renewed his above-mentioned abandoned application, as shown on the face of his patent No. 1,050,929, issued January 21, 1913. (Page 89 of Record).

On March 27, 1913, said original contract and its supplement, were cancelled by written agreement of the parties thereto for a cash settlement and consideration paid to Eaid. (Defendants' Exhibit 4, Page 91 of Record).

On June 28, 1913, three months later, Eaid having learned of the McConnell patent (it had been cited by the Patent Office on January 25, 1911, against his pending application), purchased an undivided one-fourth interest in it, as per copy of assignment. (Page 75 of Record).

Mr. McConnell testified at the trial, April 22, 1914 (Page 31 of Record), that he met Mr. Eaid about a year ago, and that he never had any dealings with him other than the negotiating of that assignment.

Eaid testified (Page 42 of Record), "I knew that the McConnell patent was in existence and had a copy of it *for some time* at the time (December 22, 1911), I made the contract with Twohy Bros." He had no interest in it, however, until three months after his contract with Twohy Bros. had been cancelled by agreement.

Eaid also testified (page 45 of Record) *that he "never made a full sized working bunk involving the construction as embodied in" the McConnell model.*

Eaid also states (Page 49 of the Record), regarding the McConnell patent of which he had learned, that he *"thought there were some principles involved in the McConnell patent at that time—this block here operated on a trunnion with a pivot—which I might possibly want to use, and I didn't believe I could get around."* This indicates that Eaid, for the first time had brought to his mind *the idea of a chock having trunnions and being pivotally mounted.* Reference to the Eaid patents, pages 87 and 89, clearly indicates that nothing of the kind is suggested therein.

DEFENDANTS' CONTENTION.

Defendants contend that the Chandler Bunk does not infringe the McConnell patent. This was the clear and unqualified decision of the Court below, after hearing the testimony in connection with the models of the two inventions, and after carefully analyzing the claims of the McConnell patent with the improvements embodied in the Chandler Bunk.

The issuing of the Chandler patent nearly five years after the McConnell patent issued, while not conclusive, yet, as stated by the Court below (Page 19 of Record): *it engenders a presumption prima facie that there is a patentable distinction or difference between the later and the earlier devices.*" Citing:

Electric Candy Machine Co. v. Morris, 156 Fed. 972, 975.

This presumption is strengthened by the fact that ten comparatively broad claims were allowed for the improvements described in the Chandler patent, and the patent was actually issued within four months from the time the application therefor was filed.

The McConnell patent was not at any time cited against the Chandler application.

PATENTS CLASSIFIED.

Patents are classified under the decisions as either PRIMARY or SECONDARY, the former being subject to liberal interpretation or construction, and the latter being subject to very strict and close construction. The leading cases on this subject are:

McCormick v. Talcott, 20 Howd. 402.

Railway Co. v. Sayles, 97 U. S. 554.

Morley Mch. Co. v. Lancaster, 129 U. S. 273.

Kokomo Fence Co. v. Kitselman, 189 U. S. 8.

As Judge Taft states it in *Penfield v. Chambers Bros. Co.*, 92 Fed. 630-649:

"The more meritorious the invention, the greater the step in the art, the less the suggestion of the improvement in the prior art, the more liberal are the courts in applying in favor of the patentee the doctoring of equivalents. The narrower the line between the faculty exercised in inventing a device and mechanical skill, the stricter are the courts in rejecting the claim of equivalents by the patentee in respect of alleged infringements."

In the case *Railway Co. v. Sayles*, above cited, on the question of Secondary patents, we have this language:

"If the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete whole, then each is entitled only to the specific form of device which he produces, and every other inventor is entitled to his own specific form, so long as it differs from those of his competitors, and does not include theirs."

"It clearly appears that complainant was not a pioneer in this department of machinery. Many inventors had preceded him and many patents had been issued. We think the case is one where, in view of

the state of the art the patentee is entitled, at the most, only to the precise devices mentioned in the claims.”—*Boyd v. Janesville*, 158 U. S. 260.

The man who first conceived the idea of providing a supporting bolster, or bunk, with a holding chock *which could be released at will*, so as to drop down away from the log and permit the latter to roll from the bunk, or bolster, was entitled to a *Primary* patent for his idea. Any good mechanic, after the suggestion of the idea, could design various mechanisms to accomplish the result. A second step, or a first improvement, in the art was to provide a chock, which, *in addition to being tripped* so as to automatically release the log, *could be adjusted to different positions* on the supporting bunk, and thereby adapt said bunk to hold one or more logs. A third step, or a second improvement, in this art was to provide in such bunk, a holding chock with releasing means therefor *which could be manipulated from the opposite side of the car*, thus making it possible for a person to stand in a safe place when releasing the chocks.

All three of these broad ideas were fully and clearly disclosed in a number of prior patents long before McConnell, Eaid, or Chandler entered the field. Thus, the reason why these patents have specific claims.

Referring first to patent No. 513,124, issued to Matheny, January 23, 1894 (Defendants' Exhibit 7, Page 93 of the Record), we have this language, page 1, lines 14 to 18:

"The object is to provide a bunk which may be convenient to load, will hold the logs securely both against rolling off and sliding thereon, and may be *easily and safely* unloaded."

and in lines 89 to 95, same page, we find the following:

"To hold the logs from rolling off sidewise, I use chock blocks C, or cheese blocks as they are sometimes called. *These are adjustable to different positions on the bunk and may be dropped down level with the top of the bunk so that the logs may roll off unhindered.*"

The claims of this Matheny patent clearly indicate *that even it was not a Primary patent, although it was issued exactly fourteen years before the McConnell patent application was filed, and has been public property for four years.*

Referring to patent No. 790,915, issued to Parsons, May 30, 1905, Defendants' Exhibit 8, Page 95 of the Record, we again have the broad idea suggested in the following language (lines 9 to 17, page 1):

"This invention relates to means for securing logs, lumber, and like material upon the bolsters of trucks or running-gear of cars or wagons used in the hauling of same.

The invention aims to provide for ready adjustment of the chock or load-retainer upon the bolster, the firm securance of the same in the adjusted position, and its quick release when it is required to unload."

The foregoing patents, with others, were cited by the Patent Office against the application on which the McConnell patent afterwards issued. This is shown in the file wrapper of the McConnell patent (Defendants' Exhibit 5, here in court, but not printed as a part

of the Record), and because of these prior patents, certain differentiating limitations were necessary in the McConnell claims, and were inserted by amendment in order to distinguish them from the prior art, and in order that a patent might be allowed thereon.

Regarding the Matheny patent cited, the Examiner said (Page 13 of said Exhibit 5):

"The chock C is pivoted and slides; means for limiting the movement of the chock are C¹ and plates S; means for actuating the chock are levers L—L and their connections to plates S—S."

As early as 1888 we have, in the Wilbur patent No. 387,477 (Defendants' Exhibit 10, Page 99 of the Record), a disclosure of a bunk with adjustable holding chocks thereon, capable of being manipulated from the opposite side of the car and moved down out of the way, so as to permit the load to be discharged from the car.

In 1899, in the Thompson patent No. 416,128 (Defendants' Exhibit 11, Page 101 of the Record), there is clearly shown a pivotally mounted chock adapted to be actuated, or positively moved in either direction, by connecting rods very similar to McConnell's.

It is very clear, therefore, from the prior art, that neither the McConnell patent, nor the Chandler patent can be considered as a Primary patent, and if the devices therein shown and described involve more than mechanical skill and rise to the dignity of invention, these patents can at best be considered only as Secondary patents, covering different mechanical means for performing in different ways, functions which had

been performed many years prior by similar devices, and they must, therefore, if their claims are to be sustained, be limited to the specific elements and limitations set forth therein.

LAW

A construction broad enough to cover infringement by equivalency may defeat the claim, because broadening the construction broadens the danger of anticipation.—Pope v. Gormully, 144 U. S. 238;

A broad claim, such as is now insisted upon, would make his claim void for anticipation. In view of the history of devices intended to perform the same function, his patent can only be saved by confining him to the specific form he has described and claimed.—Jeffrey v. Independent, 83 Fed. 191; 27 C. C. A. 512.

The means by which this or any other result or function is accomplished may be many and various, and, if those several means are not mechanical equivalents, each of them is patentable.—Boyden v. Westinghouse, 70 Fed. 816; 17 C. C. A. 430.

Where the margin of invention is very narrow, the doctrine of equivalents cannot be invoked to make out infringement.—Doze v. Smith, 69 Fed. 1002; 16 C. C. A. 581.

If complainant's claim should receive such construction as would cover defendant's machine, then it was clearly anticipated in the prior devices already referred to; that if valid under a narrow and restricted construction, which would limit the patent to the specific

device described in the specification, then it is not infringed by defendants.—Fox v. Perkins, 52 Fed. 205; 3 C. C. A. 32.

If the claims of the patent in suit were so construed as to charge the defendant with infringement, the claims would be void for want of novelty; if construed so as to avoid anticipation, defendant does not infringe.—Gates v. Fraser, 55 Fed. 409; 5 C. C. A. 154.

McCONNELL BUNK.

Referring to the specification and drawings of the McConnell patent (Page 73 of the Record), the mechanical features which were considered to be new and on which the patent is based, are specifically described on page 1 of its specification, lines 72 to 93, and are shown in enlarged special views in Fig. 3 and Fig. 4 of the drawings. The new features comprise a pair of

“combined guide and stop devices such as shown in Fig. 3 and each of which consists of a face plate 14 having an integral longitudinally extending ratchet bar 15. A longitudinally channeled guide 16 is formed integral with plate 14 and located above but beyond the side of the ratchet bar. Four of these guide and stop devices are used in connection with each pair of beams 3, said devices being arranged in pairs as indicated in Fig. 1, and adjacent the ends of the beams. Interposed between the stop devices of each pair is a chock consisting of a bowed or curved arm 17 having trunnions 18 designed to travel within the guides 16. Those portions of the trunnions outside of the guides and above the ratchet bars 15 are provided with cam faces 19 terminating in shoulders 20 designed, when the arm 17 is swung upward, to turn downward into engagement with the adjoining teeth of the ratchet bars.”

By referring to the left hand side of Fig. 1, which is a plan view looking down on top of the device, it will readily be seen how the *opposite ends of the trunnions 18 slide in the channeled guides 16*, and how the *cam portions 19 of said trunnions move directly above the ratchet bars 18 of said combined guide and stop devices*.

By reference to the right hand end of Fig. 2, it will be seen how the shoulders 20, of said cams 19, move down to engage with the adjoining teeth of the ratchet bars 15, "when the arm 17 is swung upward." These *cam shoulders 20*, projecting downwardly into the ratchet bars 15, *when the chock is raised*, prevent said chock from sliding outwardly in the channeled guides 16. There is nothing else to prevent this.

Referring to lines 93 to 103, page 1 of said patent, we find described specific *means for actuating* (pulling and pushing) *the chock called for in the claims*.

"An arm 21 extends downward from each of the chocks and *pivotaly connected to it is a link 22* having a series of apertures 23, any one of which is designed to receive a wrist pin 24 extending from arm 21. The link 22 of one of the chocks is connected to a *crank arm 25* extending from the adjoining shaft 5 while the chock at the other side of the car is similarly connected to the crank arm 25 extending from the other shaft 4."

Referring back now to lines 51 to 57, we find these shafts 4 and 5 described as follows:

"Parallel *actuating shafts 4 and 5* are journaled within the middle portions of all of the beams employed and extending from the middle portion of each of these shafts is an arm 6 to which is pivot-

ally connected the forked end 7 of an *actuating rod 8.*"

Thus by means of the *actuating rods 8* and the *actuating shafts 5*, and their *connecting crank arms 25* and *links 22*, the chock 17 can be *positively actuated in either direction*, that is, *pulled out of engagement* with the "stop devices" or *pushed into engagement* therewith.

Referring to page 2 of the patent specification, beginning in line 6, we find this operation described in the following language:

"The operator releases the bars 8 and *pushes* them inwardly. This will cause shafts 4 and 5 to be partly rotated and motion will be transmitted through arms 25 to links 22. Arms 21 will therefore be swung outwardly and *move the shoulders 20 downward into engagement with the adjoining ratchet teeth.* This operation will bring the shaft 5, wrist pin 24, and the pivotal connection between link 22 and the arm 25 practically in alignment so that each chock becomes locked in an elevated position and it is impossible to lower it by exerting pressure there against."

Referring to line 25:

"When it is desired to dump the logs the car is placed in an inclined position and the operator goes to the elevated side of the car and *pulls outwardly upon the operating arm 8.* This causes the shaft to which the bar is connected to partly rotate and to *pull on its link 22.* The arms 21 of the chocks at the lower side of the car will thus be *pulled inwardly simultaneously* and the *partial rotation of the trunnions which is thus produced serves to withdraw the shoulders 20 from engagement with the ratchet teeth* and the chock is free to swing downward and move inwardly."

It is clear, therefore, from the patent itself, that, as stated in the opinion of the Court below (Page 17 of the Record): "the chock can not be lowered, when the pressure of the logs is against it, except by *pulling the co-operating rods outwardly*. The chocks are slidable in the channeled guides, and *when lowered* may be adjusted to suit the size of the logs being loaded, but *not when elevated or locked*."

Mr. Eaid testified regarding McConnell's bunk (Page 34 of the Record), "in *pulling* this bar (8) there it *throws* the chock down in that position, unlocks it and *throws* it down, so the log can roll off on the opposite side. The principle of it is to *adjust this block, to shove it in any place* so that you can adjust it to take different sized loads of logs * * * The part we claim patent on is this block, a block operating on a *trunnion here, and manner of operating the block when in upright position to hold against the thrust of the logs*."

The testimony of complainants' expert, Clinton F. Blake (Pages 55 and 56 of the Record), on cross examination, clearly shows that he did not understand the operation of the McConnell device, or that he deliberately tried to mislead the Court, for in answer to the question: "Is it not also true that the cam portion designated 19, shown clearly in figure 4, is so positioned as to move over these notches when the chock is in one position, and when in another position the cam portion 19 moves down into and engages the notches 15?" he answered, "No, sir. The cam portion 19 seems never to enter the slots. Seems never to enter the notches." This, as seen, is contradicted absolutely by the specification of the patent itself.

Referring to pages 59 and 60, said expert, Blake, gave the following testimony regarding the operation of the McConnell device:

"The means for lowering the chock in the McConnell patent is this arm 25 and the link 22. Through the shaft 5 and the link 25, and the arm or link 22 the chock of the McConnell patent is positively moved or positively actuated, the purpose being to draw these cams out of engagement with the fixed stop devices. In a full sized working machine it would be necessary to have such a device as this for positively moving the chock to disengage it from the stop devices."

In the McConnell device, without the cams 19 and their shoulders 20, formed as a part of the trunnions 18, to engage the ratchet bar 15 when the chock is raised, the device would not operate, *for there is absolutely nothing to prevent the upper end of the chock from being pushed along outwardly in the guides 16, were it not for these ratchet-teeth, or "stop devices."*

CHANDLER BUNK.

Referring now to the Chandler device, the construction briefly described, comprises a box-like body provided at its opposite inner sides with two brackets 6—6, having corrugated upper edges forming *trunnion seats*, and a chock 9, having trunnions 10, which are interchangeably seated in the corrugations or seats of the bracket members 6. The upper end of the chock 9 projects upwardly through a longitudinally extending slot, as 5, in the top of the box-like body. *The chock is movable by hand from one seat to another at any time, whether in its raised or down position.* It is pro-

vided at its lower end with a projecting lip or flange 11, shown in Figs. 2 and 3. A latch 12 hinged to the inside of the body, as at 7, is adapted to be swung inwardly over the projecting lip or flange 11, by means of a rocker rod 13, having an offset portion or kink 15, which, when the rod 13 is turned by means of its handle 16, moves the latch 12 toward the chock and over its projecting lip or flange 11. This latch 12, therefore, prevents the chock from turning on its trunnions 10. *The Chandler chock is adjusted by hand and there is no "actuating rod" or lever connected to it "for positively moving" it, or for adjusting it along any slideway.* It must be lifted from one seat over to another.

CLAIMS.—THE LAW.

The claim is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is, and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different *from the plain import of its terms.*

Westinghouse v. Edison, 63 F. R. 588, C. C. A. 11-342.

That the prior state of the Art to which an invention belongs must be considered in construing any claims for that invention, see

Mattox v. U. S. 156 U. S. 237 (260).

Dederick v. Seigmund, 51 F. R. 233 (235).

Brush Elec. Co. v. Electric Imp. Co., 52 F. R. 972.

Boston Lasting Mch. Co. v. Woodward, 53 F. R. 481.

In view of the prior state of the Art and the proceedings had in the Patent Office, the claim of complainants' patent should be construed against him and be restricted to the particular device described.

Warren v. Casey, 93 Fed. 963, 36 C. C. A. 29, citing Mahn v. Harwood, 112 U. S. 354, Sargent v. Lock, 114 U. S. 63.

Of course an inventor cannot by the mere use of the word "means," in reference to the accomplishment of a designated function in a combination claim, appropriate any and all kinds of mechanism or devices which may perform the specified function, or any other mechanism or device than that which is described in the patent, or which is its equivalent. Reference must be had to the specifications to ascertain the means which are made an element of the claim and are protected by the patent.—American v. Hickmott, 142 Fed. 141; 73 C. C. A. 359.

While the claims specify the physical elements of the combinations, they do not specify the means whereby those elements perform their intended functions, but call for "means" generally for performing them. By this is not meant all possible means for accomplishing the result. Such comprehensiveness of claim would not be patentable. The claims in question by direct terms refer to the specification for the means by which the function, purpose, or object of the invention is to be accomplished, and to that we must look for them.—Union v. Diamond, 162 Fed. 148; 89 C. C. A. 172.

Dryfoos v. Wiese, 124 U. S. 32.

"No principle has been more firmly established and consistently applied in the Federal Courts of last resort, than that the patent must be construed in conformity with the self-imposed limitations contained in the claims. The application of this principle of construction may be invoked in support of the validity of the patent as well as denial of infringement."—Matheson v. Campbell, 69 F. R. 597.

McClain v. Ortmayer, 141 U. S. 419.

Groth v. Postal Supply Co., 61 Fed. 287.

Groth v. International, 61 Fed. 284.

Keystone Bridge Co. v. Iron Co., 95 U. S. 278.

Wright v. Yuengling, 155 U. S. 47.

Where a claim ascribes a function to any of the things which it specifies, that ascription is a limitation of that claim.

Masseth v. Larkin, 111 F. R. 409.

Eppler v. Campbell, 86 Fed. 141 (143).

Quoting from Masseth v. Larkin:

"To ignore the express functional limitation of the claim, viz.: 'Arms adapted to engage with the sides of the hole,' would be to create a new claim, not interpret the one granted."

Quoting from Anthony v. Gennert, 108 F. R. 396; 47 C. C. A. 426:

"To ignore the express functional limitation of the claim, viz.: 'Whereby they (wings) are enabled to fold back into the case side by side,' would be to create a new claim, not interpret the one granted."

In *Eppler v. Campbell*, 86 F. R. 141; 29 C. C. A. 616, we have:

"On a legal construction of this claim, anything which does not possess this function and this action, no matter to what extent in other particulars it may answer its cause, does not infringe it."

Changes made while the application is pending in Patent Office to meet objections, must be given effect in construing patent issued on amended application without regard to whether it was required by the prior art.

Campbell v. American Shipbuilding Co., 179 Fed. 498.

Safety Oiler Co. v. Scovill Mfg. Co., 110 F. R. 203.

Crawford v. Heysinger, 123 U. S. 589 (602).

Bate Refrigerating Co. v. Eastman, 24 F. R. 649.

The proceedings in the Patent Office, and the language of the specification and claims, place certain limitation upon the patent. The claim was rejected on references and finally submitted in the form in which it appears.

Lovell v. Johnson, 91 Fed. 160; 33 C. C. A. 426.

McCONNELL'S CLAIMS.

In considering the claims of the McConnell patent relied upon in this suit, it is necessary to consider in connection therewith certain amendments made to the claims while in the Patent Office in order to meet the objections of the Examiner, and to differentiate the

claims from the prior patents cited by him against them. The claims as originally submitted, the Patent Office actions, and the amendments are all shown in the file wrapper of the McConnell patent, which is Defendant's Exhibit 5, here in court, but not printed in the Record.

The following are the amendments made to the McConnell claims to avoid the prior art:

“Claim 1, line 4, before ‘means’ insert ‘fixed’; line 5, before ‘to’ insert ‘*only*.’ Same line, cancel ‘swinging’ and substitute ‘*sliding*.’”

Claim 2, line 2, after ‘devices’ insert ‘*fixedly*’; line 4, after ‘devices’ insert ‘*only when the chocks are raised*’; line 5, cancel ‘rotation’ and substitute ‘*sliding movement*.’”

Claim 4, line 2, after ‘devices’ insert ‘*fixedly*’; line 4, after ‘devices’ insert ‘*only when the chock is raised*.’”

Claim 10 was submitted with the amendment.

McCONNELL CLAIM 1.

Claim 1 may be analyzed as follows:

1. Parallel beams.
2. Means for securing the beams to a car platform.
3. Oppositely disposed chocks pivotally and movably mounted between the beams.
4. Fixed means for engaging the chocks when elevated only to hold them against sliding movement in one direction.
5. Means carried by the beams for actuating the chocks.

Referring to the changes made in Claim 1, we find that "fixed" was inserted before "means," line 5, that "only" was inserted before "to," line 6, and that "sliding" was substituted for "swinging," in line 7.

Analyzing Claim 1 of the McConnell patent with the Matheny device, the Matheny bunk has no "parallel beams," but has one heavy beam or body. Nor has the Chandler bunk parallel beams, but a box within which its mechanism is mounted and protected.

The Matheny patent has "*means for securing the bunk body to the car platform,*" which are the rods H—H.

The Matheny patent shows "*oppositely disposed chocks (C) pivotally and movably mounted.*"

It will be noticed that the Matheny chocks C are not only pivoted on trunnions, but that these trunnions c—c, slide in slide-ways b—b, similar to the McConnell construction. The Chandler chock has trunnions seated in bearing seats, but there is no slide-way and while the chock is movable, it must be moved by being lifted bodily by hand from one seat to another.

The Matheny patent also shows "*fixed means for engaging the chocks when elevated only to hold them against sliding movement in one direction,*" and as stated by the Examiner in one of his actions against the McConnell application, the "means for limiting the movement of the chock are C¹ and plates S." The qualifying word "*fixed*" which was inserted in the McConnell claim was required, therefore, to distinguish it from the Matheny patent, for this patent shows

movable means for engaging the chock when elevated only, which movable means is its slide plate S. When in one position it underlies the fixed arm C¹ of the chock when the chock is raised, and when said plate S has been shifted it allows the chock C to move down into the position shown in dotted lines, figure 4 of the Matheny patent.

It should also be noted of the Matheny device that the web which has in it the holes t, t, is really a *fixed means*, or stop device, for engaging the chocks when elevated, and also when down, and holds them against sliding movement in both directions. The Matheny chock must be lifted slightly before it can be slid in either direction. The qualifying word "only," inserted in McConnell's Claim 1, was required, therefore, to differentiate it from the Matheny construction, for Matheny's fixed means, the web, or plate having the holes t, t, therethrough, engages the chock C, for holding it against sliding movement in either direction, when elevated, and also when lowered.

The Matheny patent also shows, "means carried by the beams for actuating the chocks," which means, as stated by the Examiner, "are levers L—L and their connections to plates S—S." Now if, as complainants contend, Chandler's trip latch, which simply releases the chock to permit it to act automatically, is means for *actuating* the chock, then the Matheny patent, which also shows a means for releasing or tripping the chock so that it falls automatically, as does Chandler's, then the Matheny patent anticipates McConnell's claim in this respect also. However, McConnell has a very dif-

ferent means for actuating his chock, for he positively pushes and positively pulls his chock into different positions. His chock, by reason of the frictional contact between the flat surfaces of the shoulders 20, and the flat surfaces of the ratchet bar 15, requires that the chock must be pulled when the weight is upon it (Eaid's testimony, page 34 of Record, and Blake's testimony, bottom of page 59 and top of page 60 of Record) Neither Matheny nor Chandler is required to thus positively actuate his chock, for their constructions are such that as soon as the holding means are moved, the chocks are released and automatically fall or turn under their own weight.

The qualifying word "only," inserted between "elevated" and "to" in line 6, Claim 1, McConnell patent, was also required for the reason that *only when the chock is raised, can the "fixed means" (ratchet bar 15) engage the chock so as to hold it against sliding movement, that is, only when McConnell's chock is up, is its cam portion 19 down in holding engagement with said "fixed means," and only when the chock is down, is its cam portion 19 out of engagement with ratchet bar 15, so that the chock can be slid on its trunnions 18 in the guideway 16.*

The substitution of the word "sliding" for the word "swinging," in line 7 of the claim, was made for the reason that the chock is not thus held against "swinging" movement, but is held against a "sliding" movement.

The Court below got a clear understanding of the invention from the testimony of the experts in connec-

tion with the models, and regarding Claim 1, states:

“The fixed means for engaging the chock are the ratchet-teeth, and the engagement is effected when the chock is elevated only. This holds the chock against sliding movement in one direction. The means carried by the beams for actuating the chock are the rods and their mechanism with the cross-shafts and crank-arms.”

Defendants would urge that the Court below erred in reading into Claim 1, line 6 of the McConnell patent, a comma after the word “only,” where none appears in the patent. *It is only necessary to refer to the amendments made in claims 2 and 4 at the same time*, to determine what was intended, and what construction should be placed thereon. In Claim 2, the insertion after the word “devices” was: *only when the chocks are raised*; and in Claim 4, the insertion after the word “device” was: *only when the chock is raised*. If the word “only” was intended to apply to the clause: “to hold them against sliding movement,” as counsel for complainants contend, then a comma *before the word* “only” would have been included as a part of the insertion at the time the claim was amended. The Rules of Practice require this. The language in the specification, the operation of the invention itself, and the testimony of the witnesses, all very clearly establish the fact that the qualifying word “only” refers to the elevated position of the chock, for *only when the chocks are elevated, are they engaged by the fixed means* (ratchet bars), which hold them against sliding movement. *The words inserted in claims 2 and 4, at the*

same time claim 1 was amended, and for the same purpose, is the strongest kind of evidence to support our contention that the Court below did not err in its reading of Claim 1.

Reading Claim 1 of the McConnell patent with the Chandler device, we find that the Chandler device does not have "parallel beams," but has a metal box, or "body," *within which its mechanism is all contained and protected.*

The Chandler device has no "*fixed means for engaging the chocks when elevated only* to hold them against sliding movement in one direction." If, as counsel for complainants contend, Chandler's corrugated brackets are "*fixed means*" for engaging the chocks when elevated, then, *they engage the chock at all times, whether the chock is elevated or whether it is down,* and hold the chock against sliding movement in either direction. The supporting brackets 6 of the Chandler bunk pivotally support the chock in different positions *so as to permit it to swing freely and automatically* when released. As the Court below said (Page 21 of Record):

"If it be said that the bracket-seats in the Chandler device are stop devices, then the chock is always in engagement with them, and not when in an elevated position only. The chock can be adjusted at all times by moving it forward or back, whether in an elevated position or not, and whether the means for engaging the chock are set or not. The movement consists in raising the chock from the bracket-seats in which it rests and dropping it into others, and cannot be appropriately termed a sliding movement."

The Chandler device has no "means carried by the beams for *actuating* the chocks." The term "actuating," as used throughout the McConnell patent, must necessarily refer to a *positive movement*,—a pushing or pulling thereof, and the means "for actuating the chock" are the links 22, *which are "pivotally connected to" the lower ends of the chocks and by means of which the chocks are positively raised, and positively lowered, and positively slid on the guide-ways 16 to different positions.* On the contrary, the Chandler chock has *no means for actuating it, or for moving it.* It is *freely supported upon its trunnions in its bracket seats 6.* *It is moved or lifted from one seat to another by hand. It can be thus moved whether in its raised position or lowered position. In fact, it is more convenient to move it when it is raised, for then it projects upwardly so as to be easily gripped by the hand.* There are no actuating rods or links or other equivalent members "connected to" its lower end, by means of which it can be moved. There is a swinging latch which is swung out over the lower end of the chock when it is down, but this is not a means *for moving the chock* and it does not prevent or *in any way interfere* with the movement thereof, no matter in what position the chock may be.

McCONNELL CLAIM 10.

Analyzing Claim 10 of the McConnell patent, the elements are:

1. A chock.
2. Stop devices for engagement with the chock when in one position.

3. Means for lowering the chock to disengage it from said devices and for sliding the chock while in lowered position.

If we eliminate the qualifying functional statements from this claim we have simply: a chock, stop devices, and means for lowering the chock, all of which are found in any of the prior patents. For example, in the Matheny patent we have a chock C (which also shows trunnions and slide-ways), stop devices S "for engagement with the chock when in one position," and means for lowering the chock, which are, as Examiner says, "levers L—L and their connections to the plates S—S."

In the Wilbur patent we have the chock D, the stop devices, which are the serrated bars C which hold the chock against movement in one direction, and means for lowering the chock, which is the trip rod G.

Claim 10 is absolutely met by the Matheny patent and other prior patents, if we omit the differentiating functional statements from said claim.

In this claim, the functional statement, "*for engagement with the chock when in one position,*" which qualifies the "stop devices," reads clearly on the plate S in the Matheny patent, for this plate is certainly a stop device which engages the chock C when in its up position. In fact all stop devices must engage the chocks in at least one position. Then there is in the Matheny patent the web or plate which has the holes t, t, therethrough, which is the real stop device for preventing the Matheny chock C from sliding in either direction. His slide plate S prevents the chock C from

swinging from the up to the down position, but the other plates having the holes *t, t,* to receive the arm *C*¹ of the chock *C*, holds it against sliding.

In this claim also the "*means for lowering the chock*" is differentiated by the functional statement, "*to disengage it from said device,*" and also by the functional statement "*for sliding the chock while in lowered position.*" Without the differentiating statement, "*to engage it from said devices,*" the claim would read absolutely on the Matheny device, for this patent certainly shows "*means for lowering the chock.*" All similar bunks, as we have seen, have means for lowering the chocks. The McConnell means for lowering his chock is the connecting link 22, which, with its connections, is pivotally connected to the lower end of his chock for the purpose of positively moving the same, and this link is used not only for lowering the chock *to disengage it from said devices*, but also *for sliding the chock while in lowered position.*

In the Chandler bunk there are no stop devices, such as called for in the McConnell patent, which engage the chock at one time and not at another. The Chandler chock has no means for lowering it *to disengage it from said devices*, for *it is never disengaged therefrom*, if its seats in the brackets 6 are to be considered stop devices; nor has the Chandler device "*means for sliding the chock while in lowered position,*" nor while in any position, for *it is moved by hand only and then must be lifted bodily from one seat to another.* It is never disengaged except when lifted bodily out of the seats.

The claim fails absolutely to read on the Chandler device, and any construction which would make it read on the Chandler device would absolutely invalidate the claim, for there are many earlier patents on which said claim 10 would read, if the functional differentiating statements are omitted.

If these functional differentiating statements, which were brought into the claims by amendment, were considered by the Patent Office to be sufficient to differentiate said claims from the prior patents, which the Examiner had cited, then it is absolutely necessary that they should be considered important in construing the claims. We submit that the McConnell device and the Chandler device are mechanically very different and operate very differently in performing the functions for which they were designed. There is absolutely no part of one device which could be substituted for a corresponding part of the other device without a complete reconstruction thereof. It is only necessary to look at the parts to determine this, and in order for one part to be the equivalent of another part, even in patents which might be considered Primary, that part must be the same as the other part and do the same work in substantially the same way, and accomplish substantially the same result.

We respectfully submit, therefore, that the Chandler device does not infringe the McConnell patent in any sense of the word for the following reasons:

First. The McConnell patent, because of the prior state of the art relating to car bunks, is a Secondary

patent and must be strictly construed if it is to be held valid.

Second. The claims of the McConnell patent are differentiated from the prior art by functional statements, and if these functional statements are omitted the claims are absolutely anticipated element for element in patents issued long prior thereto.

Third. Claims 1, 2 and 4 of the McConnell patent were amended during the prosecution of the application in the Patent Office so as to meet the objections thereto by the Examiner, and in order to differentiate said claims from prior patents cited by him. Those amendments were then held to differentiate said claims from the prior art, and they must now be held to differentiate them from the Chandler bunk.

As stated by the Court below, the other claims of the McConnell patent are all narrower than the claims considered, and need not be analyzed separately.

Very respectfully submitted,

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